

REMARKS

The Official Action of August 16, 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The specification has been amended at page 14 to delete the hyperlinks, as requested by the Examiner, whereby to remove the basis for the objection to the specification. The dependency of claim 18 has now been corrected to remove the basis for the rejection under 35 USC 112, second paragraph.

The indication that claims 22, 24 and 26 would be allowable, if rewritten in independent form including all of the limitations of the base claim and any intervening claims, has been noted with appreciation. Claim 22 has now been amended to include the limitations formerly in claims 17 and 22; claim 23 has now been amended to include the limitations formerly in claims 23 and 24; and claim 25 has now been amended to include the limitations formerly in claims 25 and 26. Claims 22, 23 and 25 are now respectfully believed to be in allowable form in accordance with the Examiner's comments.

Claim 17 has now been amended to incorporate the "consisting essentially of" limitations from claim 21 (now canceled) and to require that the recited primers selectively amplify a fragment of a mitochondrial cytochrome b gene fragment of about 472 base pairs that varies among at least 221 different species. Support for these recitations appears in the specification as filed at, for example, page 11, second and third paragraphs. These recitations

are respectfully believed to obviate the rejection under 35 USC 102(b) for alleged anticipation by Matthee et al., as next discussed.

The claimed primers, when used in combination in a polymerase chain reaction, selectively amplify a unique segment of mitochondrial cytochrome b gene comprising about 472 base pairs by which an animal of unknown origin can be identified. The Examiner has not contended that the sequences described in the cited Matthee et al reference would accomplish this selective amplification, but has merely contended that the claims are open-ended such that they allegedly read on the sequences described in Matthee et al. Applicants respectfully disagree.

First, Applicants respectfully note that the transitional “consisting essentially of” is not open-ended, but occupies a middle ground between the transitonals “comprising” and “consisting of”. As discussed in MPEP Section 2111.03, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Claim 17 has now been amended to recite the basic and novel characteristics of the recited primers.

It is respectfully submitted that the recitations now in claim 17 and the “consisting essentially of” transitional close the claim to large DNA sequences, such as those described in Matthee et al, which cannot be used as primers selectively to amplify a unique segment of a

cytochrome b gene of about 472 base pairs which varies among at least 221 species and which can thus be used to identify an animal of unknown species. Accordingly, it is respectfully submitted that the claims as amended are not anticipated by the cited reference. Moreover, since there is nothing in the prior art that would show or suggest modifying the larger fragments shown in the reference to arrive at the claimed primers, the reference also cannot be said to set forth even a *prima facie* case under 35 USC 103 (see MPEP Section 706.02(j)).

Upon allowance of product claim 17, it is respectfully requested that the withdrawn method claims, which are dependent from claim 17 and therefore contain all the limitations thereof, be rejoined pursuant to the provisions of MPEP Section 821.04.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

CLIFFORD J. MASS
HADAS & PARRY LLP
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO.30,086(212)708-1890